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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,806	08/22/2001	Herman Uytterhoeven	212967	8829

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EXAMINER

CHEA, THORL

ART UNIT PAPER NUMBER

1752

DATE MAILED 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/934,806

Applicant(s)

UYTTERHOEVEN ET AL

Examiner

Thorl Chea

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133)
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 and 17 is/are allowed.
- 6) ☐ Claim(s) 5, 6, 8-16 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 5-6, 14 and 16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gilliams et al (Gilliams).

Gilliam discloses an aqueous dispersion containing silver salt of aliphatic carboxylic acid and silver halide in column 17, example 3; column 17, example 6; in column 21, example 19; and column 4, lines 23-28 and in column 9, lines 21-40. Gilliam in column 15, Examples 1 discloses the use sodium hydroxide to provide the aqueous solution to pH of 8.7 and in column 17; Example 2 discloses the formation of silver halide in-situ using the conversion of silver behenate. The aqueous solution in Example 2, column 17 contains 0.079 moles and 0.022 mole of silver halide.

The aqueous solution claimed in the present claimed invention and that taught in Gilliams are identical, except that composition of the claimed invention contains ex-situ

silver halide whereas silver halide taught in Gilliam is made by in-situ process, but the pH of the composition are the same. Accordingly, it is asserted that the composition as claimed is either anticipated or found obvious over Gilliam. Moreover, the invention as claimed is related to the claiming of a material by a process. "(E)ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of prior art, the claim is unpatentable even though the prior art product was made by different process." In re Thorpe 777 F.2d 695, 698, 227 USPQ 694, 966 (Fed. Cir. 1985).

4. Claims 8, 10, 11, 15 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Gilliams et al ('616). Note to Gilliam in column 17, Examples 2, and column 15, Example 1 which discloses the preparation of silver behenate and in-situ silver halide by first forming an aqueous solution having an pH of 8.7 using sodium hydroxide to control the pH thereof and then using conversion process by adding drop wise of potassium bromide. The aqueous solution contains 0.079 mole silver halide behenate and 0,022 moles of silver halide. Gilliam taught the process and the aqueous composition containing in-situ silver halide and light-insensitive silver salt of organic acid as claimed and the claims invention lacks novelty.

5. Claims 9, 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilliam et al ('616).

Gilliam discloses to regulate the pH by adding acidic or alkaline solution in column 6, lines 33-37; organic reducing agent in column 8, lines 38-58. It would have been obvious to use reducing agent in the aqueous solution for reduction of light insensitive silver salt of an organic acid such as suggested therein to provide the claimed composition. The use of the basic solution such as ammonia to regulate the pH has been common in the art.

Response to Arguments

6. Applicant's arguments filed December 9, 2002 have been fully considered but they are not persuasive because the reason set forth in the previous office action. It is also the Examiner's position that the additional argument submitted on June 2, 2002 is not persuasive. The step of forming the aqueous composition containing the organic silver salt and silver halide using pH higher than 8.0 is taught in Gilliam. There is no difference in processing step as how to increase the pH claimed in the present claimed invention and that taught in Gilliam. The scope of increasing the pH claimed in the claimed invention encompasses the step of adding the behenic acid with the solution of sodium hydroxide taught in Gilliam. The applicants fail to provide a convincing evidence that the pH of 8.7 taught in Gilliam decrease to less than pH 8.0 claimed in the present claimed invention. This argument with respect to pH of the prior art process is around 5.0 is based on the Cousels'assertion. The claims fails to state whether that the pH of at least 8.0 is maintaining throughout the process. The specification on page 19, Table does not show that the prior the pH of the prior art is around 5.0 such as stated in the applicants'argument. Also, the argument with respect to step of increasing the pH

provided in the specification is not persuasive since the language or the processing presented in the specification is not read into the claimed invention. Although a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitation contained in the specification into the claims. See *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitation to the claim that are not recited in the claim. Counsel's arguments cannot take the place of evidence. *In re Greenfield*, 571 F. 2d 1185, 197 USPQ 227 (CCPA 1978).

The argument with the unexpected results is not persuasive since "(E)vidence of secondary considerations, such as unexpected results or commercial success, is irrelevant to 35 U.S.C 102 rejections and thus cannot overcome a rejection so based. *In re Wiggins*, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973). Note to claims 8, 10, 11, 15 wherein the silver halide is made by in-situe at pH of 8.7. Claims 5-6, 14 are related to the use of ex-situe photosensitive halide, the composition thereof is the same as taught in Gilliams even though they are made by different process. "(E)ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of prior art, the claim is unpatentable even though the prior art product was made by different process." *In re Thorpe* 777 F.2d 695, 698, 227 USPQ 694, 966 (Fed. Cir. 1985). The applicants fails to

show as to why the claimed material are patentably distinct over the material of Gilliams. The argument with respect to unexpected results is not persuasive the material presented in the specification was not prepared according to the teaching of Gilliams especially Example 1, and moreover, the argument with respect to the unexpected results is based on the Counsel's assertion. Counsel's arguments cannot take the place of evidence. In re Greenfield, 571 F. 2d 1185, 197 USPQ 227 (CCPA 1978).

7. Claims 1-4, 7, 17 are allowed over Gilliams since Gilliams fails to teach or fairly suggest the process of raising the pH of the aqueous dispersion to pH of at least 8.0 when the ex-situ photosensitive silver halide is used. The allowance of claims 8-10, and 13 set forth in the previous office action are withdrawn in view of newly found that Gilliams discloses to adjust pH of the aqueous dispersion to 8.7 such as set forth above.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The supplemental disclosure statement filed December 9, 2002 has been considered and made of record.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9301 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

tchea
August 11, 2003


Thorl Chea
Primary Examiner
Art Unit 1752